

## **STATUS OF CLAIMS**

Claims 1, 14 and 22-38 are pending.

Claims 1, 14 and 22-38 stand rejected.

## **REMARKS**

Applicant and its attorneys thank Examiner Laneau for the courtesy of the telephonic interview of January 24, 2007. Applicant has received the Examiner's interview summary dated January 30, 2007. Applicant notes the interview summary reflects limitations that have been present in the claims and arguments Applicant has raised in its prior submissions, including its prior Appeal brief, such that no new issues were raised.

Claims 1, 14 and 22-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Goodwin et al (US2003/0220867) in view of McAfee et al (US 6,718,312), and further in view of Li (US 6,453,303). Applicant traverses, and requests reconsideration and removal of these rejections for at least the following reasons.

### ***I. Procedural History of the Present Rejections***

Then pending Claims 1 and 3-21 were finally rejected in a September 15, 2005 Final Office action as being unpatentable over Goodwin in view of Wilkinson (US 2002/0099637). More particularly, the September 15, 2005 Final Office action argued Goodwin discloses identifying potential buyers for a claim or asset (as is evidenced by paragraph [0101] thereof) and then notifying selected ones of method identified potential buyers of the availability of the at least one claim or asset (as is evidenced by paragraph [0118] thereof).

Applicant appealed these rejections of Claims 1 and 14 (having canceled Claims 3-13 and 15-21 for purposes of simplifying the issues for appeal). Applicant argued in its appeal brief that the claimed computer implemented method and system themselves identify potential buyers for a claim or asset; and then notify ones of the identified buyers that were selected. This may be considered a *push-type* approach, in that notifications are pushed to potential buyers the method and system themselves have identified and selected for at least one claim or

asset – as opposed to a *pull-type* approach that would require potential buyers to identify themselves as interested in at least one particular claim or asset and essentially pull notifications there-regarding.

Applicant explained that paragraph [0101] of Goodwin does not evidence a computer implemented affirmative step of identifying potential buyers for the at least one claim or asset using at least one of a plurality of factors comprising previous purchasing behavior, industry links and market research. And, that a detailed reading of paragraph [0101] reveals that while the Goodwin system may store some data associated with users and have interfaces thereto, paragraph [0101] of Goodwin does *not* teach or suggest *a computer method that includes the step of identifying potential buyers* – and hence, certainly *cannot* teach or suggest *a computer method that identifies potential buyers for a particular claim or asset using at least one of a plurality of factors comprising previous purchasing behavior, industry links and market research* as is recited by Claim 1.

Applicant further explained that paragraph [0118] of Goodwin does not evidence a computer implemented affirmative step of notifying selected ones of the potential buyers of the availability of said at least one claim or asset. Rather, paragraph [0118] of Goodwin explains that sellers can be notified *whenever a buyer has expressed interest* in a financial product that the seller is selling, and buyers can be notified as to the closing date for bids on the product or service *he/she has expressed interest in*. Thus, while paragraph [0118] of Goodwin may teach system notifications in general, it fails to teach or suggest *notifying selected ones* of the potential buyers that were identified using at least one of a plurality of factors comprising previous purchasing behavior, industry links and market research *of the availability* of the at least one claim or asset. In other words, Goodwin does not teach or suggest the *push approach* recited by Claim 1, but instead describes a *pull approach*, wherein buyers are notified as to the closing date for bids on the product or service *he/she has expressed interest in*.

Finally, Applicant noted that the teachings of the secondary reference Wilkinson relied upon in the final rejection of Claims 1 and 14 did nothing to remedy the considerable

deficiencies of Goodwin, as discussed above, as the Final Office action clearly relied upon Goodwin for the aforementioned features.

In response to Applicant's Appeal Brief, the Examiner re-opened prosecution and issued a new, non-final Office action on August 14, 2006. This new, non-final Office action rejected Claims 1 and 14 as being unpatentable over Goodwin in view of a new secondary reference McAfee. However, the August 14, 2006 Office action failed to address Applicant's grounds for traversing and appealing the prior rejections of Claims 1 and 14 in the first place – namely the failure of Goodwin to teach the recited identifying and notifying steps (i.e., the push approach). Instead, the August 14, 2006 Office action merely substituted McAfee for Wilkinson.

In an effort to clarify the positions of Applicant and the Patent Office, Applicant initiated a telephonic interview with Examiner Laneau on October 5, 2006. During the interview, Examiner Laneau suggested Applicant amend Claims 1 and 14 to recite the features of previously cancelled Claim 3, which based on the Examiner's comments, Applicant understood would place the application in condition for allowance. Pursuant thereto, without prejudice, and subject to Applicant's right to seek further prosecution of the previously claimed subject matter, Applicant filed an Amendment and Response on October 20, 2006, amending Claims 1 and 14 to recite subject matter originally recited in previously cancelled Claim 3, consistent with the October 5, 2006 Examiner's telephonic interview.

On January 11, 2007, another Final Office action was mailed rejecting each of the pending claims over Goodwin in view of McAfee, and now further in view of Li. However, the January 11, 2007 Final Office action still fails to address Applicant's grounds for traversing and appealing the prior rejections of Claims 1 and 14 – namely the failure of Goodwin to teach the recited identifying and notifying steps (i.e., the push approach).

## ***II. Standard for Unpatentability Under 35 U.S.C. 103(a)***

To establish a *prima facie* case of obviousness under 35 U.S.C. 103(a), all of the recited claim limitations must be taught or suggested in the prior art. *See, M.P.E.P. 706.02(j); see*

*also, M.P.E.P. 2143.03 citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.") and In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. See, M.P.E.P. §706.02(j); see also, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).*

As discussed below, the cited prior art references, both singly and in combination, fail to teach, or suggest, all of the limitations of any of the pending Claims – and hence fail to render any of the pending claims unpatentable as a matter of law. Further, a proper motivation for combining the references as argued in the January 2007 Final Office action is lacking – such that a *prima facie* case of obviousness has not been made.

### **III. 35 U.S.C. 103(a) Rejection of Claim 1**

Claim 1 recites, in part, "[a] computer method of auctioning at least one claim or asset in bankruptcy over a communications network, said method comprising: [1] identifying potential buyers for said at least one claim or asset using at least one of a plurality of factors comprising previous purchasing behavior, industry links and market research; [and] [2] notifying selected ones of the potential buyers of the availability of said at least one claim or asset." Thus, Claim 1 is directed to a computer method of auctioning at least one claim or asset in bankruptcy over a communications network that *pushes* claim or asset availability information to selected potential buyers *by: (1) identifying potential buyers for the at least one claim or asset using at least one of a plurality of factors comprising previous purchasing behavior, industry links and market research; and (2) notifying selected ones of the identified potential buyers of the availability of the at least one claim or asset.*

Thus, the method of Claim 1 itself drives the auction process by (1) identifying potential buyers using a data store, and (2) notifying ones of the identified buyers that were selected. In contrast, the cited art fails to teach such a *push-type* computer method, and in fact actually teaches the opposite -- a method that requires potential buyers drive the process by

***pulling item information*** that they select. That is, the Goodwin reference requires potential buyers pull general notifications by expressing interest in particular items.

The January 2007 Final Office action maintains its reliance upon paragraph [0101] of Goodwin to support the assertion that Goodwin teaches the first recited step of Claim 1 -- identifying potential buyers for the at least one claim or asset using at least one of a plurality of factors comprising previous purchasing behavior, industry links and market research. Applicant traverses this assertion. Paragraph [0101] of Goodwin merely explains that user management subsystem 40 provides user management functions. More particularly, paragraph [0101] of Goodwin teaches user management subsystem 40 merely provides an interface to data. Examples of the data provided are: user profile data, user preference data, stored search/filter results, lists of financial products for which a user has purchased due diligence or other information, a user registration component to handle initial site registration, login/authentication functions. Finally, paragraph [0101] mentions an interface that allows a system administrator or quality control person to "activate" the ability for a Buyer or Seller to conduct transactions.

Thus, a detailed reading of paragraph [0101] reveals that contrary to the assertions of the January 2007 Final Office action, while the Goodwin system may store some data associated with users and have interfaces thereto, it does ***not*** teach or suggest ***a computer method that includes the affirmative step of identifying potential buyers*** at all – let alone ***a computer method that itself identifies potential buyers for a particular claim or asset using at least one of a plurality of factors comprising previous purchasing behavior, industry links and market research*** as is recited by Claim 1. Further, as is discussed below, not only does Goodwin fail to teach or suggest such an identifying step, it actually teaches the opposite – in at least that it requires potential buyers to identify themselves.

For purposes of completeness, Applicant submits McAfee as applied in the January 2007 Final Office action (like Wilkinson) fails to remedy at least this shortcoming of Goodwin – at least by virtue that McAfee is merely relied upon for its purported teachings regarding determining market values. Applicant further submits that Li also fails to remedy at least this

shortcoming of Goodwin, at least by virtue that Li is relied upon merely for its purported teachings regarding historical sales data.

For at least these reasons, a prima facie case of obviousness has not been met; reconsideration and removal of this 35 USC 103 rejection is requested.

Further yet, the Final Office action relies upon paragraph [0118] of Goodwin to support the assertion that Goodwin teaches the second recited step of Claim 1 -- notifying selected ones of the potential buyers of the availability of said at least one claim or asset. Applicant traverses this assertion as well. Paragraph [0118] of Goodwin teaches a notifier subsystem 66 generates notifications. However, Claim 1 does not simply call for “notifying”. The present invention lies in the specifics as claimed, rather than in the general notion of notifying. To this end, Claim 1 calls for notifying selected potential buyers that the method has identified “*of the availability of the at least one claim or asset*” in bankruptcy. The claimed method thus calls for a *push-type* approach to making potential buyers aware that a claim or asset is available. In contrast, Goodwin explains that *sellers can be notified whenever a buyer has expressed interest in a financial product that the seller is selling*, and *buyers can be notified* as to the closing date for bids *on the product or service he/she has expressed interest in*.

Thus, while paragraph [0118] of Goodwin may teach system notifications in general, it fails to teach or suggest *notifying selected ones of the potential buyers that were identified using at least one of a plurality of factors comprising previous purchasing behavior, industry links and market research of the availability of the at least one claim or asset – e.g., the push approach* recited by Claim 1. In contrast, Goodwin employs a *pull approach* wherein *buyers are notified* as to the closing date for bids *on the product or service he/she has expressed interest in*. See, e.g., Goodwin, par. [0018].

Again for purposes of completeness, Applicant submits McAfee as applied in the January 2007 Final Office action (like Wilkinson) fails to remedy at least this shortcoming of Goodwin. And, that Li also fails to remedy at least this shortcoming of Goodwin, at least by virtue that Li is relied upon merely for its purported teachings regarding historical sales data.

For at least these additional reasons, a prima facie case of obviousness has not been met; reconsideration and removal of this 35 USC 103 rejection is requested.

In summary, Claim 1 recites a computer method that *pushes* claim or asset information *by: (1) identifying potential buyers for the at least one claim* or asset using at least one of a plurality of factors comprising previous purchasing behavior, industry links and market research (e.g., searching a database); *and (2) notifying selected ones of the identified potential buyers of the availability of the at least one claim or asset* (e.g., by the user preferred method). Put another way, the method of Claim 1 necessarily calls for a computer method that itself identifies buyers, selects ones of the identified buyers and notifies the selected buyers that a claim or asset is available (e.g., pushes notification), while *Goodwin instead requires buyers to identify themselves* and then merely sends notifications to them (e.g., *pull notifications*).

Accordingly, Applicant respectfully requests reconsideration and removal of the rejection of Claim 1, as a *prima facie* case of obviousness has not been met, at least by virtue that the asserted combination of Goodwin, McAfee and Li fail to teach, or suggest, each of the limitations of Claim 1 – namely at least the recited: (1) identifying potential buyers for said at least one claim or asset using at least one of a plurality of factors comprising previous purchasing behavior, industry links and market research; and (2) notifying selected ones of the potential buyers of the availability of said at least one claim or asset.

Notwithstanding that the foregoing is sufficient to require reconsideration and removal of the rejection of Claim 1, Applicant further submits that a proper motivation for combining Goodwin, McAfee and Li in the manner asserted in the January 2007 final Office action is lacking.

The January 2007 Final Office action argues while Goodwin fails to disclose determining a market value, McAfee teaches such a step, such that it would have been obvious to incorporate such a step into the system of Goodwin. Applicant traverses this assertion as well.

The Final Office action refers to col. 5, lines 19-45 as supporting the assertion that McAfee teaches determining a market value using historical data of a same or similar asset. *See, 1/11/2007 Office action, pg.3, ll. 5-6.* Applicant traverses this assertion, at least by virtue of

the January 2007 Final Office action's admission that McAfee fails to teach such a limitation.<sup>1</sup> That is, the Office action admits McAfee fails to teach or suggest using historical data of a same or similar asset. *See, 1/11/2007 Office action, pg.3, ll. 5-6.* Thus, it is clear that McAfee cannot teach or suggest determining a market value using historical data of a same or similar asset.

Notwithstanding this deficiency of the Final Office action, Applicant further traverses this assertion at least by virtue that lines 19-45 of column 5 of McAfee discuss combinatorial auctions and the theory of static combinatorial bidding. McAfee merely discusses that combinatorial bidding has been used by bankruptcy trustees, and, in theory, leads to maximizing the value actually realized by the auction. Contrary to the assertions of the January 2007 Office action, like Goodwin, nowhere does this cited portion of McAfee teach or suggest a computerized method that includes the affirmative step of determining a market value, no less determining a market value of the at least one claim or asset in bankruptcy using historical data of the same or similar assets – as is recited by Claim 1. Instead, it merely suggests that one type of auction that may be well suited for being used in certain circumstances is a combinatorial static auction.

Accordingly, Applicant respectfully requests reconsideration and removal of the rejection of Claim 1, as a *prima facie* case of obviousness has not been met, at least by virtue that contrary to the assertions of the January 2007 Final Office action, McAfee (like Goodwin) fails to teach or suggest a computerized method for auctioning at least one claim or asset in bankruptcy that includes the affirmative step of determining a market value of the at least one claim or asset using historical data.

Further yet, Li fails to remedy at least this shortcoming of Goodwin and McAfee, as a proper motivation for incorporating the system of Li into either the auction system of Goodwin and/or McAfee is lacking.

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<sup>1</sup> Applicant notes the Final Office action itself expressly contradicts the assertion that McAfee teaches determining a market value using historical data of a same or similar asset, as it expressly admits McAfee fails to teach using historical data of a same or similar asset in the first place. *See, 1/11/2007 Office action, pg.3, ll. 5-6.*



As the January 2007 Final Office action cited portion of McAfee explains, auctions are concerned with maximizing value received – because there is no established price for the items being auctioned. In contrast, Li is directed to trading liquidities, such as stocks, bonds, securities and commodities. *See, col. 1, l. 14 – col. 2, l. 4.* Li seeks to provide market commentary and commentary updates for liquidities having rapidly moving, price establishing, liquid markets – to mitigate bad investment decisions. *See, e.g., col. 1, ll. 59-65.* Li is not concerned with auctioning at all. Indeed, were such a price establishing, liquid market available for claims or assets in bankruptcy that Li seeks to leverage, *no auction would be required in the first place*, as the claims or assets could instead simply be sold on that market.

Accordingly, a proper motivation for importing the liquidity trading functionality of Li into the auction system of Goodwin or McAfee is thus lacking, absent impermissible hindsight gleaned from Applicant's own disclosure, as auction processes and systems in general, and auction processes and systems for claims and assets in bankruptcy in particular, are not akin to liquidities exchange in rapidly moving liquid markets.

In view of the foregoing, Applicant respectfully requests reconsideration and removal of the rejection of Claim 1, as a *prima facie* case of obviousness has not been met, at least by virtue that a proper motivation for combining the teachings of Goodwin, McAfee and Li in the manner argued in the January 2007 Office action is clearly lacking, absent impermissible hindsight gleaned from Applicant's own disclosure.

#### ***IV. 35 U.S.C. 103(a) Rejection of Claim 14***

In a similar fashion to patentably distinct Claim 1, independent Claim 14 recites, in part, “[a] computer system for auctioning at least one claim or asset in bankruptcy over a communications network comprising: ... [1] a code for identifying potential buyers for said at least one claim or asset using at least one of a plurality of factors, the factors comprising previous purchasing behavior, industry links and market research; [and] [2] code for notifying selected ones of the potential buyers of the availability of said at least one claim or asset.”

Application No. 10/034,151  
Amendment dated February 8, 2007  
Reply to Final Office Action of January 11, 2007

Thus, Applicant submits Claim 14 is distinguishable from the cited art of record for reasons analogous to those presented regarding Claim 1. And, that a proper motivation for combining the teachings of Goodwin, McAfee and Li is lacking for at least those reasons set forth above as well. Accordingly, Applicant respectfully requests reconsideration and removal of the rejection of Claim 14, as a *prima facie* case of obviousness has not been met.

***IV. 35 U.S.C. 103(a) Rejection of Claims 22-38***

Applicant also requests reconsideration and removal of the rejections of Claims 22-38 as well, at least by virtue of these Claims' ultimate dependency upon a patentably distinct base Claim 1 or 14.

**CONCLUSION**

Applicant believes he has addressed all outstanding grounds raised in the outstanding Office action, and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited.

Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,



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